



UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY DOCKET NO.
08/798,115	02/12/97	ALLENAN	J PARA-1479
			EXAMINER

26M1/0829  
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INVENTOR'S NAME	PAPER NUMBER
2601	14

DATE MAILED: 08/29/97

This is a communication from the examiner in charge of your application.  
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### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 6/18/97, 8/7/97 and 8/28/97
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-13 and 18-20 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-13 and 18-20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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**DETAILED ACTION**

*Specification*

1. The disclosure is objected to because of the following informality:

Page 1 has been amended to show that this application is "continuation of application number 08/252,984 filed 6/2/94". The disclosure should also be amended to show that application number 08/252,984 is continuation of application number 07/873,323 filed 4/24/92 which is now abandoned.

Appropriate correction is required.

2. A substitute specification is required because the preliminary amendment filed 6/18/97 introduces extensive changes which are difficult to enter, consider and print. The lengthy amendment to the specification has not been entered. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office. The substitute specification should conform to MPEP § 608.01(q), which requires the submission of a "marked-up" copy which shows additions to and/or deletions from the original specification and a "clean copy."

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*Response to Amendment*

3. The preliminary amendment filed 6/18/97 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The deletion of the admission of prior art (specifically, the deletion of language in lines 25 and 31-33 of page 3) represent new matter.

Since the amendment to the specification has not been entered, Applicant is required to exclude the above new matter from future amendments.

*Claim Rejections - 35 USC § 112*

4. Claims 1 - 13 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, line 21, "said input data" lacks antecedent basis. In lines 10-11, "said station" lacks antecedent basis.

In claims 1 and 10, the language is confusing because it implies that the system originates a call [back] to the subscriber while the subscriber is attempting to connect to the system.

Claims 2-9 and 11-13 are rejected because they depend from rejected claims 1 and 10.

In claim 5, line 9, "said number" is indefinite.

In claim 13, the language regarding assigning the DID number to the calling party station (subscriber station) is confusing. The DID is the number dialed by the authorized subscriber. The

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exchange simply passes along the DID which is dialed by the subscriber. Further, the step of "retrieving the stored said direct inward dial number assigned to that calling party" is vague because the DID is received from the exchange (not retrieved from storage).

In claim 18, step (b), "the incoming signals" are indefinite and lacks antecedent basis. In step (d), "the telephone number" of the identified subscriber is indefinite. Is this the same as the "subscriber number" in step (a)?

Dependent Claim 19 is rejected because it depends from rejected claim 18.

In claim 20, to avoid confusion, steps (a) and (b) should be labeled (g) and (h).

***Claim Rejections - 35 USC § 102 and 103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 - 3 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by **Kahn et al** (US Patent 4,086,438).

**Kahn et al** discloses an automatic interconnection telephone system 30 ("central location") for answering incoming calls and connecting the calling party to an outgoing line for

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making an outgoing call(s). The calling party calls the telephone system and provides a security code which will be compared with stored codes by security code circuit 200 to verify the identity of the calling party. Entering the security code into the system by the calling party is read as placing "a signal containing data uniquely identifying the subscriber" (claim 1) or "entering a subscriber number into the telephone system" (claim 18). The reference teaches that the calling party can hang up ("calling party terminates the call to the telephone system") and then the telephone system can initiate a call-back to the calling party after which a dial tone will be provided to the calling party to enter the telephone number of a third party to establish an outgoing call(s) using the telephone system. See abstract and col. 2, line 48 - col. 3, line 6.

For claims 2 and 3, the reference also teaches transmitting an audio signal ("audio message") to inform the calling party that he has reached the system 30. The reference also teaches the use of a timer 121 for allowing the calling party to provide the security code within 15 seconds ("predetermined period of time"). If the calling party does not enter a code within the 15-second period, the system will disconnect the calling party from the system (see col. 27, lines 26-39).

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kahn et al** (US Patent 4,086,438).

For claim 4, the reference does not suggest informing the calling party of the favorable comparison (i.e., confirmation), however, confirming that a security code provided by the calling party is valid is notoriously well known in the art. Usually, a message such as "Thank you" or "thank you for using ..." is provided to the calling party as confirmation of entry of a valid code. As a matter of fact, the above confirmation is necessary to let the calling party known just in case he makes a mistake while entering the code.

For claim 5, instead of having the calling party enter a security code, it would have been obvious to one of ordinary skill in the art to utilize the well known DID information which is automatically provided by the telephone company. This would be faster, easier, convenient and more accurate than manual entry of a code by the calling party.

9. Claims 1 - 4, 6 - 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kahn et al** (US Patent 4,086,438) in view of **Billinger et al** (US Patent 4,769,834).

For independent claims 1, 10 and 18, in the above rejection under 35 USC 102(b), the claimed "signal containing data uniquely identifying the subscriber" (claim 1) and "entering a subscriber number" (claim 18) can be read as the calling party manually entering the security

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code into the telephone system to identify the calling party as a subscriber. While not claimed in claim 1 and 18, if the above steps are performed automatically without the calling party providing manual entry, then this would read on the use of the well-known Automatic Number Identification ANI feature as disclosed, for example, by **Billinger et al**. The ANI is also read as the “signal ... is transmitted by said exchange (claim 10). The **Billinger et al** reference explicitly teaches the use of information provided automatically by the telephone company such as the ANI to eliminate the need for the calling party to dial an authorization code. The ANI information is used by the telephone company to automatically inform the system of the number of the calling party. Using the ANI instead of authorization code means that the calling party can be identified without answering the call (free call). Also, using the ANI provides advantages such as speed, accuracy and convenience because having the calling party manually enter his number may cause delay and sometimes the calling party may make a mistake while entering the number. In general, providing a number automatically is preferred over providing the number manually. Again, the calling party can be identified without having the calling party pay for the call.

Thus, while updating the **Kahn et al** system (filed in March 1977) to meet the current well known technological standards as disclosed in **Billinger et al**, it would have been obvious to utilize the information provided automatically by the telephone company such as the ANI information to automatically identify the originating station.

For claims 2 and 3, in the combination of references, the system will verify the identity of the calling party by using the ANI and without answering the call and then the system will

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callback the subscriber. Thus, obviously, the subscriber is expected to let the system ring for a short period of time and then hang up. If the system continues to receive ringing signals for a predetermined period of time (e.g., 10 rings), obviously the calling party is either not a subscriber or a new subscriber that is not very familiar with the system. Obviously the system should provide the calling party with an appropriate informative message and advise him or her to terminate the connection attempt (e.g., "You have reached ..... please ...") because this calling party would unnecessarily tie up an incoming line.

For claim 6, obviously (if not inherently), the subscriber usage of the system is determined for billing purposes.

For claims 7 - 9, **Kahn** teaches (col. 33, line 65 - col. 34, line 6) that if the calling party encounters a busy or no-answer ("failure of the third party to answer the call attempt"), the calling party may make another call without hanging up by simply pressing the "\*" button on his dual tone multi-frequency tone DTMF telephone. The DTMF tone represented by the "\*" button is detected by tone detector 301 (Fig. 10). The reference does not suggest the use of means for informing the caller of his options, however, messages such as "you may press \* to dial another number" and the like are notoriously well known in the art and it would have been obvious to use a well known Voice Response Unit VRU for advising the calling party of his options.

For claims 11 and 12, systems are expected to keep the calling party/ subscriber informed of the progress of the call by using the well known Voice Response Unit VRU to provide audio messages. Messages such as "the number you have entered is invalid," "please hang up ....", etc.



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have been used for many years and it would have been obvious and necessary to keep the calling party informed of the progress of the call attempt. No one expects silence when he or she dials a wrong number such as a DID number that has not been assigned yet. The arguments presented above for claim 2 apply to claim 12.

For claim 4, the **Billinger et al** reference teaches (col. 3, lines 33-47) that the identity of calling party may be verified by using the ANI information only or the ANI and the authorization code. The reference teaches that the system requests information such as the authorization code from the calling party. In the combination of the reference, confirming to the calling party that a valid authorization code was received would have been obvious and necessary.

10. Claims 1 - 13 and 18 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kahn et al** (US Patent 4,769,834) in view of **Curtin** (US Patent 4,672,660).

While not recited in claims 1, 10 and 18, language regarding the signal .... identifying the subscriber (claims 1 and 10) and "entering a subscriber number into the telephone system" (claim 18) may be interpreted as being entered by using the direct inward dialing DID. This limitation is recited in claims 5, 13 and 19.

Again, to identify the calling party, **Kahn et al** (filed in March 1977) uses the authorization code which is manually provided by the calling party. The **Curtin** reference explicitly teaches the use of information provided automatically by the telephone company (DID) to identify the calling party without answering the call (see abstract). Under description of the

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prior art in col. 1, lines 16-44, **Curtin** states that the use of a code which is manually provided by the calling party to identify the calling party is disadvantageous and undesirable for different reasons. Instead, **Curtin** teaches the use of the Direct Inward Dialing DID feature to "automatically", "easily" and "rapidly" identify the calling party without answering the call and without the need for the calling party to manually enter a code (see col. 1, lines 39-44, col. 2, lines 61-65). Using the DID feature as taught by **Curtin** in the **Kahn et al** system will eliminate the need for the calling party to dial an authorization code as clearly suggested by **Curtin**. Using the DID as suggested by **Curtin** to identify the calling party (instead of authorization code) means that the calling party in **Kahn et al** can be identified without answering the call (free call). Utilizing the DID also provides advantages such as speed, accuracy and convenience because having the calling party manually enter his or her number may cause delay and sometimes the calling party may make a mistake while entering the number. In general, providing a number automatically is preferred over providing the number manually. Further, the calling party can be identified without having the calling party pay for the call.

Thus, modifying the 1977 **Kahn et al** system (which uses a code manually entered by the calling party in order to identify the calling party) by replacing the manual entry of a code with the automatic DID as clearly and positively suggested by **Curtin** would have been obvious for the reason discussed in detail by **Curtin**.

For claims 2 and 3, in the combination of references, the system will verify the identity of the calling party by using the ANI and without answering the call and then the system will

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callback the subscriber. Thus, obviously, the subscriber is expected to let the system ring for a short period of time and then hang up. If the system continues to receive ringing signals for a predetermined period of time (e.g., 10 rings), obviously the calling party is either not a subscriber or a new subscriber that is not very familiar with the system. Obviously the system should provide the calling party with an appropriate informative message and advise him or her to terminate the connection attempt (e.g., "You have reached ..... please ...") because this calling party would unnecessarily tie up an incoming line.

For claims 4 and 5, while combining the two references, one may use the DID only or the DID and an authorization code for added security. Informing the calling party that a valid security code was entered would have been obvious and necessary.

For claim 6, obviously (if not inherently), the subscriber usage of the system is determined for billing purposes.

For claims 7 - 9, **Kahn** teaches (col. 33, line 65 - col. 34, line 6) that if the calling party encounters a busy or no-answer ("failure of the third party to answer the call attempt"), the calling party may make another call without hanging up by simply pressing the "\*" button on his dual tone multi-frequency tone DTMF telephone. The DTMF tone represented by the "\*" button is detected by tone detector 301 (Fig. 10). The reference does not suggest the use of means for informing the caller of his options, however, messages such as "you may press \* to dial another number" and the like are notoriously well known in the art and it would have been obvious to use a well known Voice Response Unit VRU for advising the calling party of his options.

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For claims 11 and 12, systems are expected to keep the calling party/ subscriber informed of the progress of the call by using the well known Voice Response Unit VRU to provide audio messages. Messages such as "the number you have entered is invalid", "please hang up ....", etc. have been used for many years and it would have been obvious and necessary to keep the calling party informed of the progress of the call attempt. No one expects silence when he or she dials a wrong number such as a DID number that has not been assigned yet. The arguments presented above for claim 2 apply to claim 12.

For claim 20, **Kahn et al** teaches that the calling party can enter the telephone number of one or more third parties to establish a conference call. See for example, column 3, lines 3-6.

11. Claims 1, 10, 13 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by the **IDT** international callback services as described in by the references in Examiner's Exhibit A<sup>1</sup> and Applicant's admission on pages 3-4 of the specification that the IDT is prior art.

A subscriber can call the IDT machine in the U.S. from a foreign country, hang up before the machine answers and wait for the IDT machine to call him or her back. The IDT machine will

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<sup>1</sup>Examiner's Exhibit A comprises (a) IDT Internet Web Page titled "IDT: The First Five Years", (b) Telecommunication Markets Newsletter titled "Call-back resellers give telephone companies a \$120 million headache" (August 19, 1993), (c) Telecommunication Markets Newsletter titled "Resale entrepreneurs will find life tough with the carriers" (April 1, 1993), (d) Network World Journal titled "Callback services offer users steep discounts" (June 21, 1993), (e) The Economist titled "International telephone calls, The Privateers" (September 12, 1992), (f) The New York Times titled "Hot-Wiring Overseas Telephone Calls" (January 9, 1992), (g) Business Week titled "Rome to Bonn via New Jersey" (April 13, 1992) and (h) Business Week titled "How Overseas Callers Can Get Stateside Rates" (December 2, 1991).

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call the subscriber back and provide him or her with a second line so he or she can make outgoing calls utilizing the IDT machine and thus pay at US rates. The IDT machine calls the subscriber back by using the DID number which was dialed by the subscriber. Each subscriber has his or her own unique DID number (See Examiner's Exhibit A and pages 3-4 of Applicant's specification).

For claim 1, the IDT machine is not shown to contain the claimed "means" such as "storing means" and "means for bridging", however, such components are inherent in the IDT machine. For example, the machine inherently has to have means for storing the "signal .... identifying the subscriber" (DID) and the subscriber and the third party inherently have to be connected by "means for bridging" the communication.

The IDT home page on the Internet titled "IDT: The First Five Years" shows that IDT started providing services in 1990. The Economist article (September 12, 1992) provides evidence that the IDT machine was made and used 2 ½ years before the publication date of September 12, 1996 (That is, the IDT was made and used in the US on or before March 12, 1990). The Economist discusses international call back services and states on column 2 that:

*"One of the best known discounters, 2 ½ year old International Discount Telecommunication (IDT), uses third-country calling to provide calls between countries ...."*

The Telecommunication markets Newsletter (August 19, 1993) clearly states that:

*"more than 20 companies have started international call-back services in the last three years [1990 - 1993]" and that "Viatel and International Discount*

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*Telecommunications (IDT) ... are the oldest call back providers.... Both started providing call back services in 1990."*

The Telecommunication markets Newsletter (April 1, 1993) states that:

*"The most successful operator of a call-back service is a US company, International Discount Telecommunications (IDT). A user calls from his country to IDT in New York, hangs up ..... In 1991, ... it [IDT] was worth about GBP 20 million."*

Network World journal (June 21, 1993) discusses the wide spread of the "international call-back services" and states that:

*"The market was pioneered by International Discount Telephone [sic] (IDT) ... which started service in 1990".*

*"Call back works quite simply. A caller in a foreign country dials ...."*

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12. Claims 1, 10, 13 and 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by the IDT international callback services as described in by the references in Examiner's Exhibit A<sup>2</sup> and Applicant's admission on pages 3-4 of the specification that the IDT is prior art.

Considering the dates of the publication without considering the information and dates discussed within the publications, the above claims would be rejected under 35 USC 102(a).

13. Claims 1 - 3, 6 - 13 and 18 - 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the IDT international callback services as described in by the references in Examiner's Exhibit A and Applicant's admission<sup>3</sup> on pages 3-4 of the specification that the IDT is prior art.

As discussed above, while the IDT machine performs the functions of the claimed invention, the IDT machine is not shown to contain specific components such as the claimed "means for bridging ..." and "means storing ..." and telephone exchange. If the use of the above

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<sup>2</sup>Examiner's Exhibit A comprises (a) IDT Internet Web Page titled "IDT: The First Five Years", (b) Telecommunication Markets Newsletter titled "Call-back resellers give telephone companies a \$120 million headache" (August 19, 1993), (c) Telecommunication Markets Newsletter titled "Resale entrepreneurs will find life tough with the carriers" (April 1, 1993), (d) Network World Journal titled "Callback services offer users steep discounts" (June 21, 1993), (e) The Economist titled "International telephone calls, The Privateers" (September 12, 1992), (f) The New York Times titled "Hot-Wiring Overseas Telephone Calls" (January 9, 1992), (g) Business Week titled "Rome to Bonn via New Jersey" (April 13, 1992) and (h) Business Week titled "How Overseas Callers Can Get Stateside Rates" (December 2, 1991).

<sup>3</sup>It was held that any statement by Applicant in the application that a certain matter is "prior art" to him, is an admission that the matter is prior art for all purposes, whether or not a basis in 35 USC 102 can be found for its use as prior art. *In re Nomiya*, 184 USPQ 607.

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components was not inherent, then it would be extremely obvious for one of ordinary skill in the art to utilize a telephone exchange and bridging means for connecting the subscriber and the third party and utilize "means storing ..." for storing the DID numbers.

For claims 2 and 3, a subscriber is expected to let the IDT machine ring once or twice and then hang up. If the IDT machine continues to receive ringing signals for a predetermined period of time (e.g., 10 rings), obviously the calling party is either not a subscriber or a new subscriber that is not very familiar with the system. Obviously the system should provide the calling party with an appropriate informative message and advise him or her to terminate the connection attempt (e.g., "You have reached ..... please ...") because this calling party would unnecessarily tie up an incoming line.

For claim 6, obviously (if not inherently), the subscriber usage of the system is determined for billing purposes.

For claim 7, this is a well-known feature offering the subscriber other options when the call cannot be completed (e.g., third party is busy or does not answer). Many examples such as "the number you have dialed is ....., please ....." exist in the art of telephonic communications and the advantages of such features are notoriously well known in the art.

For claim 8, this may simply read in the subscriber hanging up.

For claim 9, many telephone systems such as voice mail, Automatic Call Distributors ACDs used for telemarketing, ... etc. give the caller options such as "to end this call, press \*".



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The "\*" sign or any other chosen number is a dual tone multifrequency tone DTMF. Again, this is a well-known feature.

For claims 11 and 12, systems are expected to keep the calling party/ subscriber informed of the progress of the call by using the well known Voice Response Unit VRU to provide audio messages. Messages such as "the number you have entered is invalid", "please hang up ....", etc. have been used for many years and it would have been obvious and necessary to keep the calling party informed of the progress of the call attempt. No one expects silence when he or she dials a wrong number such as a DID number that has not been assigned yet. The arguments presented above for claim 2 apply to claim 12.

**(D) The declaration under 37 CFR 1.131 is insufficient to overcome the rejections based on the IDT machine.**

- The declaration was filed June 18, 1997 without any exhibits. The exhibits were faxed to Examiner on August 7, 1997.
- It is noted that the declaration under 37 CFR 1.131 cannot be used to swear behind **Kahn et al** (April 25, 1978), **Billinger et al** (September 6, 1988) or **Curtin** (June 9, 1987) because the date of these patents is more than one year prior to the effective filing date of this application which is April 24, 1992. That is, the above three references represent a statutory bar under 35 U.S.C. 102(b). The declaration is submitted by Applicant to swear behind the IDT international call back services.

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Regarding the date of **conception**, on page 2 of the declaration (item # 5) and Exhibit 1, it is abundantly clear that Applicant applied "to resell switched message telephone services of existing common carriers to provide international switched voice service between the US and various overseas points". There is no mention of the "call-back" feature whatsoever. As a matter of fact, there is no mention of any claimed feature whatsoever in Exhibit 1. Many companies resell international calling services (such as credit card calling, pre-paid card calling, direct international calling, voice mail .... etc.) between the U.S. and various overseas points. A company need not invent anything to resell international services. The most common international service provided by many companies is direct dialing (may sometimes require dialing an access code) of international calls. For example, one can call (one direction) from the US to France through the companies which resell international services. Thus, Applicant's Exhibits 1, which has no reference whatsoever to any claimed feature, fails to support Applicant's statement regarding the conception of the claimed invention prior to March 21, 1990. The FCC application cannot support the conception of the claimed invention.

Regarding the date of **reduction to practice**, Applicant's Exhibit 2 shows a letter from Mr. Alleman to Mr. Gunther. The letter shows that Mr. Alleman is having problems with "the router" and that he will continue to monitor "the router". It is unclear what "the router" is. No sketches, description, blue prints of "the router" have been provided. On page 2 of the declaration (item 6), it appears that Mr. Alleman was not in position of the needed software to

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make the invention compatible with the telephone equipment. The letter in Exhibit 2 clearly states "We now need to move forward on the DID software" and repeatedly uses "should" and "should be". Mr. Gunther is the programmer who is retained by Mr. Alleman to write software for the claimed invention. If the claimed invention was already reduced to practice, what is the purpose of the Exhibit 2 letter from Mr. Alleman to the software programmer? Page 5 of the declaration (item # 23), which states that Mr. completed the software by September 1990 and that Mr. Alleman was searching for a vender to prepare the complete system, is a clear indication that the claimed invention could not have been reduced to practice before June 27, 1990.

The claimed invention apparently required software which was completed by Mr. Gunther in September 1990 and hardware which was "completed" by Call Interactive on April 25, 1991. The current declaration is silent regarding the functionality and operability of the product provided by Call Interactive and the interaction between the software and the hardware.

Exhibit 5, which refers to a "System for Telecommunication **Marketing**", states that an invention, in Mr. Holloway's opinion, was discovered and reduced to practice by Mr. Alleman and that further work will be done on Mr. Alleman discovery.

Further, there appears to be some discrepancies between the current 131 declaration and the 131 declaration submitted by Mr. Alleman in the parent application 08/252,984 ('984). It is noted that some Exhibits which were present in the '984 application such as Exhibits F, G

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and H have not been included in the current application. On page 3 and 4 of the '984 declaration, Mr. Alleman states that:

*"This experimental period [April 1990 until April 25, 1991] was termed "beta" testing as shown in the attached Exhibit F and in spite of optimistic predictions of its conclusion, the present invention continued to be non-functional well past the 'live' operation date with Call Interactive.*

*As such, the present invention was not yet reduced to practice until it could be demonstrated to function properly. As evidence of this non-functioning and poor functioning, the following exhibits are entered:*

*Exhibit G: A memorandum from Kent Parkinson of Call Interactive to Tom Thomson and John Killion describing the subscriber file format for the system. The system was not fully operational and still required definition at this date [March 27, 1991].*

*Exhibit H : A letter to Mr. Theo Brunner dated December 16, 1991 indicating Paragon's attempts to correct failures in Mr. Brunner beta site operation."*

Thus, Applicant's statements in the current declaration regarding the reduction to practice before June 27, 1990 appear to be inconsistent with his statements and exhibits in the '984 declaration. For all the reasons discussed above, the evidence submitted is insufficient to establish a reduction to practice of the invention in this country prior to the date of the IDT international callback services.

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Again, the evidence as a whole contains no sketches, blue prints, notes, records of meetings .... etc.

In addition to the above reasons, (a) Applicant admits on pages 3 and 4 of the specification that the IDT machine is prior art and (b) Examiner's Exhibit A shows that the IDT callback machine has been used in the US since 1990 (statutory bar). The IDT machine is, indeed, prior art. For example, The IDT home page on the Internet titled "IDT: The First Five Years" shows that IDT started providing services in 1990. The Economist article (September 12, 1992) provides evidence that the IDT machine was made and used 2 ½ years before the publication date of September 12, 1996 (That is, the IDT was made and used in the US on or before March 12, 1990). The Economist discusses international call back services and states on column 2 that:

*"One of the best known discounters, 2 ½ year old International Discount Telecommunication (IDT), uses third-country calling to provide calls between countries ...."*

The Telecommunication markets Newsletter (August 19, 1993) clearly states that:

*"more than 20 companies have started international call-back services in the last three years [1990 - 1993]" and that "Viatel and International Discount Telecommunications (IDT) ... are the oldest call back providers.... Both started providing call back services in 1990."*

The Telecommunication markets Newsletter (April 1, 1993) states that:

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*"The most successful operator of a call-back service is a US company, International Discount Telecommunications (IDT). A user calls from his country to IDT in New York, hangs up ..... In 1991, ... it [IDT] was worth about GBP 20 million."*

Network World journal (June 21, 1993) discusses the wide spread of the "international call-back services" and states that:

*"The market was pioneered by International Discount Telephone [sic] (IDT) ... which started service in 1990".*

*"Call back works quite simply. A caller in a foreign country dials ...."*

14. **The Declaration under 37 CFR 1.132 filed August 28, 1997 is insufficient to overcome the rejections.**

Note that the declaration cannot be used to overcome rejections under 35 USC 102.

The above 103 rejections represent a clear and positive *prima facie case* of obviousness and the declaration is insufficient to overcome the rejection.

Examiner's Exhibit A shows that many companies such as IDT, Viatel and others have been using the callback feature prior to Applicant's effective filing date, thus the commercial success is not based on Applicant's contribution to the industry and Applicant's claimed invention.

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The Teleconnect Magazine article refers to dozens of companies and different callback services including different techniques such as the use of X.25, the Internet, speed dial, voice mail, debit cards, multilingual voice prompts, packet network messages, remote access by subscriber for retrieval of billing information, comparing the cost of local calls and callback calls, .... etc. that are different from the claimed invention. Also, the magazine refers to "*first generation of callback systems (manual dial-in, hang up, wait, answer, dial, etc.)*" and more sophisticated callback technologies. Thus Applicant's allegation that the commercial success is due to his claimed invention is unsupported and contrary to the Teleconnect Magazine. Thus, no nexus whatsoever has been established. It is noted that a portion of column 2, page 82 of the Teleconnect Magazine has been erased.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

**LaVallee et al** (US Patent 5,181,236) discloses an automatic call returning ("callback") system which is used for capturing the ANI information of the calling party and using the ANI for calling back the calling party. The reference teaches the use of Voice Response Unit VRU 22 for providing messages to the calling party.

**Inbound/Outbound Magazine** (October 1989 and May 1990) teaches the use of the ANI and DID information in a call center that comprises the well known Voice Response Unit. .

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**Srinivasan** (US Patent 5,185,782) discloses an automatic callback arrangement which collects the calling party ANI information and call him back later. The arrangement provide different kinds of announcements such as prompting the calling party to provide information and advising the calling party of his options.

**16. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 308-5403, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**17. Communications via Internet E-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the Applicant and should be addressed to [krista.zele@uspto.gov].**

All Internet E-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



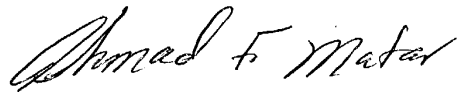
Serial Number: 08/798,115

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18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Ahmad Matar whose telephone number is (703) 305-4731.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in cursive script, reading "Ahmad F. Matar".

**Ahmad F. Matar**  
**Primary Patent Examiner**  
**Group Art Unit 2601**